



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Martin BRODT et al.

Confirmation No.: 7612

Appln. No.: 10/527,721

Art Unit: 1742

Filed: October 20, 2005

For: **PRESS-HARDENED PART AND METHOD FOR THE PRODUCTION THEREOF**

Attorney Docket No.: 3926.144

Customer No.: 30448

CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited either by facsimile to 571-273-8300 or with the U.S. Postal Service as First Class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 22, 2007.

*Yonghong Chen*  
Yonghong Chen

Reg. No. 56,150

**INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 C.F.R. §1.97 and §1.98**

**Mail Stop Amendment**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the duty of disclosure under 37 C.F.R. §1.56, Applicants hereby notify the U.S. Patent and Trademark Office of the following documents for the above-identified application. Copies of any non-US documents set forth below and listed on the attached Form PTO/SB/08A are provided herewith.

1. EP 1 143 029 A1 (corresponding to US publication No. 2001/0042393 A1, cited as Document 2)
2. US 2001/0042393 A1
3. DE 198 82 558 T1 (corresponding to US patent No. 6,293,134 B1, cited as Document 4)

4. US 6,293,134 B1
5. DE 197 43 802 C2 (corresponding to US patent No. 5,972,134, cited as Document 6)
6. US 5,972,134
7. DE 100 32 297 A1 (corresponding to US patent No. 6,470,772 B2, cited as Document 8)
8. US 6,470,772 B2
9. DE 100 55 275 A1 (corresponding to US publication No. 2004/0026562 A1, cited as Document 10)
10. US 2004/0026562 A1
11. DE 200 14 361 U1 (corresponding to US publication No. 2002/0104591 A1, cited as Document 14)
12. US 2002/0104591 A1
13. EP 1 052 295 A2 (corresponding to US publication No. 2002/0069945 A1, cited as Document 16)
14. US 2002/0069945 A1
15. OE 321 689
16. Benteler's bid letter to Adam Opel AG on February 9, 2000
17. Method-plan of Siwe AG of June 25, 2000 and July 10, 2000
18. Purchase Order to WEBA on July 6, 2000
19. Order summary by GM on February 19, 2002
20. Fax from Benteler to Siwe on February 23, 2001
21. Fax from Webba to Benteler on May 23, 2002
22. Fax from Benteler to Adam Opel AG on May 27, 2002
23. Fax from Benteler to Adam Opel AG on June 3, 2002
24. Inspection flowchart Opel ZB-reinforcement B-column J3200 dated 09.24.01/02.06/02/03.06.02.

Documents 1, 3, and 5 were cited in the opposition by BMW in the corresponding European application. Documents 2, 4, and 6 are English equivalents of Documents 1, 3, and 5, respectively. Documents 7, 9, 11, 13, and 15-24 were cited in the opposition by Benteler in the corresponding European application. Documents 8, 10, 12, and 14 are English equivalents of Documents 7, 9, 11, and 13, respectively. Documents 16-24 correspond to D12 to D20 on pages 3-4 of the opposition by Benteler.

**Explanation of Relevancy of Documents D12 - D20 Cited in the Opposition by Benteler**

Documents D12 – D20 are directed against Claim 1 of Applicants' European patent EP 1536898 B1 which has the following features:

- MI .1 Method of producing a metallic shaped part, in particular a vehicle body part, from a semi-finished product made of an unhardened hot-workable steel sheet, comprising the following method steps:
- MI .2 A part blank (10) is formed from the semi-finished product (2) by a cold-forming method, in particular a drawing method.
- MI .3 The part blank (10) is trimmed at the margins to a marginal contour (12') approximately corresponding to the part (1) to be produced.
- MI .4 The trimmed part blank (17) is heated and press-hardened in a hot-forming tool (23).

Document D12 is an opponent's bid letter directed at Adam Opel AG in the matter of "warm-forming" of a vehicle B-column (Opel J 3200). Page 5 of Document D12 shows that the components are trimmed in some regions with an accuracy of  $\pm 3.0$  mm and in other regions laser-trimmed with an accuracy of  $\pm 0.75$  mm. Document 12 does not disclose that "the trimming.., on the part blank occurs before the end-forming press-hardening inside the warm-forming-tool" (as alleged by Benteler). From pages 5 and 9 of document D12 it can be seen that the parts show marginal inaccuracies of  $\pm 3.0$  mm, which are reduced by laser to  $\pm 0.75$  mm. This indicates a laser trimming step during which the parts obtain their final contour. Document

D12, therefore, discloses a method corresponding to the state of the art (as described in [0005] - [0006] of Applicants' European patent application specification).

The method-plan in Document D13 shows a sequence of process-steps/tools for the manufacture of a B-column. They involve a blank-cut, two cold-forming-steps, two trimming-steps and one warm-forming-step. D13 does not disclose whether or to which extent the trimming steps correspond to a final contour trimming in the sense feature M1.3 of Claim 1. Documents D14 and D15 (relating to purchasing/ordering information of this tool set) is therefore superfluous.

Document D16 explicitly describes that trimming-tools are to be designed with an "allowance for laser". The attached figure shows a drawing, in which a hatched strip was manually inserted in selected border areas, supposedly indicating the described "allowance". This indicates that the finished parts are not cut close to end-contour before the warm-forming, but undergo another (laser-) trimming after the warm-forming. Incidentally, the manually inserted "allowance ... for laser" in the figure of D16 is also detectable in the drawings OP40 and OP50 of document D13, indicating that the method-plan D13 shows the forming and trimming tool for a part which undergoes laser trimming after warm forming.

The second paragraph of document D16 relates to a "change of trimming". In our opinion, this paragraph (as well as documents D17 and D18) is unclear as far as the terms "close trimming tolerance of 1.5 mm" and "finished size" are concerned. Furthermore it is to be noted that documents D17- D19, which relate to ordering of tools, originate from May/June 2002. Therefore it is impossible that these tools were used for the serial production of the Opel Epsilon 3200 B-column "starting January 2002" (as claimed by Benteler).

Document D20 is a "inspection flowchart Opel ZB-reinforcement B-column J3200" and discloses a method for producing a warm-formed part, during which a blank is cut out of a coil,

{WP394407;1}

which is then preformed, perforated and trimmed and subsequently undergoes a warm-forming step. The features M1 .1, M1 .2 and M1 .4 are therefore shown in the method of D20. However, D20 shows only a "trimming" of the pre-formed part; it is by no means evident that this step involves a contour trimming corresponding approximately to the part to be produced. In fact the flowchart of D20 shows that following the warm-forming M1 .4 a process step "laser" takes place, which indicates that the part undergoes a concluding laser-trimming after the warm-forming M1 .4. Thus, the process step "trimming" located before warm-forming cannot be a near-border-contour trimming, since otherwise the additional (laser-) trim would be superfluous. The flowchart D20 therefore describes the state of the art (described in [0005] - [0006] in Applicants' European patent). The fact that the laser trimming happens in a different production facility ("Wilco") than the pre- and warm-forming, is irrelevant.

In conclusion, Applicants believe that Documents D12 – D20 do not clearly and unambiguously disclose the subject matter of Claim 1 of Applicants' European patent.

#### **Public Accessibility of Documents D12 - D20**

According to Benteler, Documents D12 – D20 document a "collaboration" of the companies Benteler, WEBA Werkzeugbau GmbH, Siwe AG and Adam Opel GmbH. These companies obviously are related by a supplier/customer relationship with shared development activities. In such a collaboration, it is customary to use utter discretion in matters of interest to the parties involved. Thus, it is to be expected that all personnel of the parties involved handle this matter with confidentiality, even if no explicit non-disclosure agreement was signed. Benteler has given no evidence that this confidentiality was breached.

#### **First-to-Invent**

As far as the question of first-to-invent is concerned, please note the attached PowerPoint presentation dated August 29, 2000 at DaimlerChrysler.

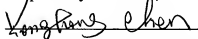
Page 3 displays a flowchart of a conventional warm-forming process involving a cold-forming step (MI .2), followed by a trimming step followed by a warm-forming step (MI .4) followed by a **final laser trimming**. In contrast, page 2 displays the method of Claim 1 involving a cold-forming step (MI .2), followed by a trimming step followed by a warm-forming step (MI .4), but without final laser trimming. This indicates that during the trimming step the borders of the workpiece were trimmed to a marginal contour approximately corresponding to the part to be produced (MI .3).

Since the present Information Disclosure Statement is being filed before the mailing date of the first Office Action, no statement under 37 C.F.R. §1.97(e) or fee under 37 C.F.R. §1.17(p) is required.

The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicants do not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

Applicants respectfully request that the listed documents be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08A be returned in accordance with MPEP §609.

Respectfully submitted,



**Date: August 22, 2007**

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Substitute for form 1449/PTO

## INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet	2	of	2
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**Complete if Known**

Application Number	10/527,721
Filing Date	10/20/2005
First Named Inventor	Martin BRO
Art Unit	1742
Examiner Name	
Attorney Docket Number	3926.144

## U. S. PATENT DOCUMENTS

[illegible]

**FOREIGN PATENT DOCUMENTS**

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document  Country Code <sup>2</sup> -Number <sup>3</sup> -Kind Code <sup>4</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear
/J.Y./		DE 200 14 361 U1	11-16-2000	Benteler AG	
/J.Y./		EP 1 052 295 A2	11-15-2000	BENTELER AG	
/J.Y./		OE 321 689	04-10-1975	EGYESZLETI IZOLÁMPA ÉS VILÁGMOSZÁR RT	

Examiner Signature	/Jie Yang/	Date Considered	02/13/2008
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\*EXAMINER: Initiate if reference considers, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kind Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 50 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

**Complete if Known**

Substitute for form 1449/PTO		<b>Application Number</b>	10/527,721
		<b>Filing Date</b>	October 20, 2005
		<b>First Named Inventor</b>	Martin BRODT
		<b>Art Unit</b>	1742
		<b>Examiner Name</b>	
<b>Sheet</b>	1	<b>of</b>	1
		<b>Attorney Docket Number</b>	3926.144

**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
		Benteler's Bid Letter to Adam Opel AG on February 9, 2000	
		Method-plan of Siwe AG of June 25, 2000 and July 10, 2000	
		Purchase Order to WEBB on July 6, 2000	
		Order Summary by GM on February 19, 2002	
		Fax From Benteler to Siwe on February 23, 2001	
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		Fax From Benteler to Adam Opel AG on May 27, 2002	
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		Inspection Flowchart Opel ZB-reinforcement B-column J3200 Dated 09.24.01/02.06/02/03.06.02.	

<b>Examiner Signature</b>	<b>Date Considered</b>
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.  
<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.  
This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments by the applicant of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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No correlated English translation files